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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,300	09/30/2003	Gilad Odinak	018.0304.US.UTL	8164
22895 7590 05/30/2007 CASCADIA INTELLECTUAL PROPERTY 500 UNION STREET SUITE 1005 SEATTLE, WA 98101			EXAMINER BRINEY III, WALTER F	
			ART UNIT 2615	PAPER NUMBER
			MAIL DATE 05/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/676,300

Applicant(s)

ODINAK ET AL.

Examiner

Walter F. Briney III

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 August 2006 has been entered.

### ***Claim Objections***

1. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 6 depends on claim 1, and is characterized as "an electronic ear plug." However, the claim refers to a programmable alarm tone programmer, which is external to the ear plug. An ear plug cannot comprise anything external to it. This claim needs to be rewritten as a system claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-10 and 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (US Patent 6,906,983) in view of the Atmel 8-bit AVR® Microcontroller with 1K Byte Flash: Attiny11/Attiny12 specification (Rev. 1006D-AVR-07/03, Copyright 2003). Note the secondary reference is being applied in accordance with the rules set forth in MPEP § 2131.01(III).

Claim 1 is limited to "an electronic ear plug for providing a programmable audible alarm." It was shown apropos the rejections of claim 1 filed 15 June 2006 and 30 January 2006 that Williams in view of the Atmel specification anticipates the "audible alarm circuit" comprising "a memory," "an interface," "a clock circuit" and "an ear plug." The instant amendment has removed the requirement for the memory to be provided separately and for the interface to be leadless. Moreover, the countdown timer has been reduced merely to the clock circuit, where the clock circuit now incorporates the limitations previously associated with an alarm circuit. These broadening amendments are then necessarily still disclosed by Williams, and in fact have eliminated the 35 USC 103(a) rejection concerning "a memory provided separately." However, the instantly recited "interface" differs from the previous presented interfaces in that it receives "the user-settable time interval and the at least one programmable alarm tone from an external source by which the at least one programmable alarm tone was programmed from a plurality of programmable alarm tones" (emphasis original). In essence, the applicant is seeking to limit the scope of the electronic ear plug by indicating the

process in which the programmable alarm tone element was made; the signature left on said element by the manufacturing process must be considered to determine the metes and bounds of the claim. Being selected/programmed from a plurality of tones, the at least one programmable alarm tone appears to have no physical signature left by the manufacturing process. Ergo, this limitation carries no patentable weight.

The above analysis of the new "interface" limitation notwithstanding, Williams discloses in column 2, lines 48-57, that prior art user interfaces integrated with an ear plug are cumbersome or awkward to use. In column 2, lines 61-67, Williams discloses providing a personal computer with software to enable programming of a time-keeping ear plug. In column 3, lines 13-22, Williams discloses providing at least a chirp sound with a programmable processor (within the ear plug) as well as the ability to play specific sounds—plural. In column 12, lines 1-3, Williams finally discloses providing a sound selection mechanism. Ergo, Williams discloses an ear plug and programmer, where the programmer provides all user interface to eliminate the awkwardness plaguing prior art ear plugs and allows the selection of specific sounds—the specific sounds being inherently loaded onto the ear plug at some point through the interface discussed in the rejection of claim 1 filed 15 June 2006, namely elements 30 and 31 seen in figure 3. The inherent downloading corresponds to "interface 30 and 31 receives the...at least one programmable alarm tone from an external source." It follows that since the computer/source providing the user interface enables the selection/programming, the computer corresponds to "an external source by which the at least one programmable alarm tone was programmed (selected) from a plurality of

programmable alarm tones (those stored on the ear plug).” Therefore, Williams in view of the Atmel ATtiny12 specification anticipates all limitations of the claim.

**Claim 6** is limited to “an electronic ear plug according to claim 1,” as covered by Williams in view of the Atmel ATtiny12 specification. The above objection to incorporating elements external to the electronic ear plug notwithstanding, it was shown apropos the rejection of claim 1 supra that Williams indeed discloses “a programmable alarm tone programmer to program (i.e., elect) the at least one programmable alarm tone from a plurality of programmable alarm tones.” Therefore, Williams in view of the Atmel ATtiny12 specification anticipates all limitations of the claim.

**Claim 8** is limited to “an electronic ear apparatus for providing a programmable audible alarm.” The instant amendments to this claim take the same form mutatis mutandis found in claim 1, and are rejected for the same reasons. Therefore, Williams in view of the Atmel ATtiny12 specification anticipates all limitations of the claim.

**Claim 9** is limited to “a programmable ear plug system providing an audible alarm.” Like stated in the treatment of claim 8, the amendments to this claim assume the form of those treated apropos claim 1. However, this claim requires “an external programmer.” The programmer contains two elements: “a programmer by which the at least one programmable alarm tone can be programmed from a plurality of programmable alarm tones” and “an external interface that is removably interfaced to the removable ear plug via the programming channel through the interface and the recharging interface.” Both elements exist in Williams. The programmer is seen in the rejection of claim 1 supra, namely the software that allows user interface with a PC

including selection of a sound. The external interface is best drawn to element 31 of figure 3 since it provides all signaling and recharging power to the processor 35 and battery 23 of Williams. Therefore, Williams in view of the ATtiny12 specification anticipates all limitations of the claim.

**Claim 17** is limited to "a method for providing a programmable audible alarm through an electronic ear plug." The rejection of claim 1 highlighted that Williams discloses providing a user interface through a PC separated from the ear plug to ameliorate the difficulty in programming an ear plug through an integrated interface and that said PC user interface includes a sound selection mechanism to choose the sound reproduced by the ear plug. In this way, use of Williams system includes "programming via the programming interface...at least one programmable alarm tone from a plurality of programmable alarm tones." Again, since the programmable alarm tone must be loaded—i.e., downloaded—to the ear plug and since all programming is done through the PORTB driver interface, which corresponds to the programming interface, Williams discloses "downloading...the at least one programmable alarm tone from the programming interface into a memory provided within the audible alarm circuit and maintained in the electronic ear plug." Therefore, Williams in view of the Atmel ATtiny12 specification anticipates all limitations of the claim.

**Claim 18** is limited to "method according to claim 17," as covered by Williams in view of the Atmel ATtiny12 specification. The "programming input control and logic through controls external to the electronic ear plug by which the at least one programmable alarm tone can be programmed (i.e., selected) from a plurality of

programmable alarm tones" was shown to be anticipated by Williams apropos the rejection of claims 1 and 17. Therefore, Williams in view of Atmel ATtiny12 specification makes obvious all limitations of the claim.

**Claims 3-5, 7, 10, 14-16 and 19-21** are rejected for the above reasons relating to their respective parent claims and the reasons presented in the Final Rejection filed 15 June 2006. Therefore, Williams in view of the Atmel ATtiny12 specification anticipates all limitations of the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Aceti (US Patent 6,253,871).**

**Claim 2** is rejected for the same reasons presented above regarding claim 1 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

2. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Knapp (US Patent 5,253,300).**



**Claim 11** is rejected for the same reasons presented above regarding claim 9 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

3. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Mizoguchi et al. (US Patent 5,566,226).

**Claim 13** is rejected for the same reasons presented above regarding claim 9 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

### ***Response to Arguments***

Applicant's arguments filed 21 August 2006 have been fully considered but they are not persuasive.

On pages 8-13 of the instant response, the applicant alleges that there exists no motivation to provide the new limitations concerning programming, by an external programmer, a programmable alarm tone from a plurality of alarm tones. However, it is the examiner's position that the cited prior art actually anticipates these limitations. Ergo, applicant's charge is a straw-man argument, mischaracterizing the examiner's position, and is moot.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

wfb  
5/25/07

  
**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**